Reconsideration of the present application is respectfully requested. No claims have been amended, canceled or added. The specification has been amended to correct minor typographical errors.

Claims 1-4, 7, 15-17, 27-29, 39-41, 44, 45, 48, 49, 52 and 53 stand rejected under 35 U.S.C. § 102(e) based on WO 00/46963 of McConnell et al. ("McConnell"). Claims 5, 6, 8-14, 18-26, 30-38, 42, 43, 46, 47, 50, 51, 54 and 55 stand rejected under 35 U.S.C. § 103(a) based on McConnell in view of U.S. Patent no. 6,233,577 of Ramasubramani et al. ("Ramasubramani").

Applicants respectfully traverse the rejections. The cited references have little relevance, if any, to Applicants' claims. Applicants' invention relates to a method of provisioning processing devices, such as mobile communication devices (e.g., cell phones and the like). In particular, claim 1 recites:

> 1. A method comprising:
> operating a first **provisioning** system authorized **to provision** a processing device on a network, wherein the **provisioning** system is within a trusted environment; and
> using the first **provisioning** system to authorize a second **provisioning** system outside the trusted environment **to provision** the processing device.
> (Emphasis added.)

McConnell has nothing whatsoever to do with provisioning and contains no disclosure, suggestion or hint of provisioning. The term "provisioning" is widely used in the field of wireless telecommunications, and its meaning is well understood by those skilled in that technology. Applicants' usage of that term is consistent with that well-understood meaning, which is to configure a device with information, so as to enable a

service to be performed on that device. See Applicants' specification at paragraph [0002], lines 2-9. Nowhere does McConnell contain the term "provisioning" or any other disclosure that falls within the ordinary meaning of that term, as used in Applicants' claims.

For at least this reason, the rejection of claim 1 based on McConnell is improper. Since all of the independent claims contain this limitation, the rejection is also improper as to each of the other claims, for the same reason.

In addition, even if one were to assume *arguendo* that McConnell disclosed "provisioning", McConnell still does not disclose or even suggest one provisioning system <u>authorizing another</u> provisioning system to provision a device, as required by claim 1. Similar limitations are present in each of the other independent claims. For this additional reason, therefore, the rejection is improper as to each of the independent claims.

In addition, claim 15 recites:

> 15. A method comprising:
>   operating a primary trusted provisioning domain (TPD); and
>   using the primary TPD to provision a mobile device on a wireless network by sending a provisioning message to the mobile device, **the provisioning message specifying a secondary TPD authorized to provision the mobile device and an identifier of one or more parameters which the secondary TPD is authorized to provision.** (Emphasis added.)

The above remarks also apply to claim 15. In addition, McConnell fails to disclose or suggest sending to a mobile device <u>a provisioning message that specifies a secondary TPD authorized to provision the mobile device and an identifier of one or more parameters which the secondary TPD is authorized to provision</u>. The Examiner

cites McConnell at p. 19, lines 17-18 as disclosing this functionality (Office Action, p. 4). However, all that is disclosed there is that a subscriber information repository may contain information that can be used to authenticate a WAP client or to control in the gateway the services (URLs) which a user is authorized to access. McConell contains no hint of a message that specifies a secondary provisioning system or TPD authorized to provision a WAP client or any other device. Likewise, McConell contains no hint of a message that specifies parameters (if any) a system can provision in a WAP client or any other device. To the extent a URL is considered a "parameter", McConnell does not disclose a URL being provisioned in a device.

Therefore, the rejection is improper as to claim 15 and all claims which depend on it for this additional reason. Independent claims 27, 40 and 48 include similar limitations to these and are therefore also patentable over the cited art for this reason.

In addition, claim 20 recites:

> 20. A method comprising:
>   operating a primary provisioning server within a predefined trusted environment, the primary provisioning server having authorization to provision a plurality of mobile devices on a wireless network;
>   using the primary provisioning server to provision a digital certificate of the primary provisioning server in each of the mobile devices;
>   using the primary provisioning server to provision a digital certificate of a secondary provisioning server in the mobile devices, wherein the secondary provisioning server is on a second network outside the trusted environment; and
>   using the primary provisioning server to provision the mobile devices with information indicating to the mobile devices authorization of the secondary provisioning server to provision the mobile devices.
> (Emphasis added.)

The above remarks regarding claim 1 also apply to claim 20. The Examiner admits that McConnell fails to disclose:

6

operating a primary provisioning server within a predefined trusted
environment, the primary provisioning server having authorization to
provision a plurality of mobile devices on a wireless network;
using the primary provisioning server to provision a digital
certificate of the primary provisioning server in each of the mobile
devices;
using the primary provisioning server to provision a digital
certificate of a secondary provisioning server in the mobile devices,
wherein the secondary provisioning server is on a second network
outside the trusted environment.

However, in rejecting claim 15 under § 103, the Examiner contends that

Ramasubramani discloses this functionality (Office Action, p. 13). In particular, the

Examiner cites Ramasubramani at col. 7, lines 10-14 (Id.) and at col. 4, lines 29-40

(Office Action, p. 9) as disclosing these features. The Examiner is mistaken.

At col. 4, lines 29-40, Ramasubramani discloses that a message may include a

hierarchical chain of digital certificates (a.k.a. digital IDs, security certificates), at the top

of which is the certificate of a certifying authority (CA). The CA is "trusted without a

certificate from any other certifying authority." However, the cited section of text does

not relate to provisioning, nor does it contain any hint of one system authorizing another

system to provision a device. Likewise, the text cited at col. 7, lines 10-14 is equally

irrelevant to Applicants' claims.

Therefore, the combination of McConnell and Ramasubramani fails to disclose all

of the limitations of claim 20 or any of the other independent claims. As such, the

rejection is improper as to claim 20 and all other independent claims in the present

application, for this additional reason.

Additionally, as to independent claims 40, 44, 48 and 52, the cited combination of

art does not disclose or suggest any functionality in a mobile device, by which the

mobile device is initially provisioned by a first trusted provisioning domain (TPD) to enable it to be subsequently provisioned by a second TPD. Further, as to claims 44 and 52, the cited art does not disclose or suggest the ability of a mobile device to distinguish between a message from a primary TPD and a message from a secondary TPD. Therefore, these claims and all claims which depend on them are patentable over the cited art for these additional reasons.

Dependent Claims

In view of the above remarks, a specific discussion of the dependent claims is considered to be unnecessary. Therefore, Applicants' silence regarding any dependent claim is not to be interpreted as agreement with, or acquiescence to, the rejection of such claim or as waiving any argument regarding that claim.

Conclusion

For the foregoing reasons, the present application is believed to be in condition for allowance, and such action is earnestly requested.

If any additional fee is required, please charge Deposit Account No. 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 5/12/05

Jordan M. Becker
Reg. No. 39,602

Customer No. 26529
12400 Wilshire Blvd.
Seventh Floor
Los Angeles, CA 90025-1026
(408) 720-8300

8